

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejections Under 35 U.S.C. §112

Although applicants do not agree with the outstanding rejection for lack of written description, in order to expedite allowance of the present application, applicants have amended the claims to overcome this rejection. Claim 71 is now directed toward a lipstick composition. In order that lipstick is considered a claim element, along with the elements herbal colorant and one or more additives, lipstick is now recited as an element in the body of the claim. The same applies for independent claims 149, 153 and 157, respectively directed to eyeshadow, glitter and rouge.

The claims have also been amended to overcome the outstanding rejections for indefiniteness.

Rejections Under 35 U.S.C. §102

Applicants traverse the rejection for anticipation for the following reasons. With respect to claim 71, one of the recited claim elements is lipstick, thereby overcoming the outstanding rejection that the recitation to lipstick is an intended use, not a physical claim recitation. Applicants urge that US Application No. 2002/0082279 (Schultz) only describes dermatologic compositions, which are generally described in the last sentence of paragraph [0003] as “a cream, ointment, lotion, solution [or] gel.”

The specific working examples of Schultz are to creams (i.e. Acid Mantle Cream, Lidex Cream, Bactroban Cream, Bendryl Cream, Diprolene Cream, or Psoricon Cream), a gel (Estar Gel), lotions (Slufacet-R Lotion, Komed Lotion, or Ludriderm Lotion) or an ointment (Aguaphor Healing Ointment). The creams, gel, lotions and ointment described by Schultz are structurally different compositions than the lipstick of claim 71. Also, Schultz only describes essentials oils, not “an herbal colorant isolated from a species belonging to the genera of the family *Boraginaceae*.” In fact neither the word color nor *Boraginaceae* appear anywhere within Schultz. Both herbal colorant and lipstick are two elements of claim 71,

neither of which are taught by Schultz. It is axiomatic in patent law that an anticipating reference must teach all the elements of a claim. Schultz, however, does not teach two of the claimed elements therefore Schultz cannot anticipate the present invention.

The same arguments apply to claims 149-152, directed toward an eye shadow, claims 153-156 directed toward a glitter composition, and claims 157-160, directed toward a rouge composition. The creams, gel, lotions and ointment described by Schultz are structurally different compositions than an eye shadow, a glitter or a rouge. Moreover, Schultz does not describe “an herbal colorant isolated from a species belonging to the genera of the family *Boraginaceae*.” Therefore, the Schultz reference cannot anticipate claims 149-160 because Schultz does not teach two of the claim elements.

Rejections Under 35 U.S.C. §103

A proper rejection for obviousness under §103 requires consideration of two factors:

- (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition, or device, or carry out the claimed process and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.

In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991) [emphasis added].

Applicants submit that the present invention is not obvious over the cited references within the meaning of section 103. As noted above, in order for a *prima facie* case of obviousness to be established, it must be shown that all the elements of a claim were taught or suggested by the prior art. In this case, no part of Schultz teaches or suggests “an herbal colorant isolated from a species belonging to the genera of the family *Boraginaceae*.” Moreover, nothing in Shultz teaches or suggests a lipstick, an eye shadow, a glitter or a rouge. Therefore a *prima facie* case of obviousness has not been established.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is felt that the present application is not in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

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